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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Golf Club of Nevada, Inc.

Serial No. 76220155

Lauri S. Thompson of Greenberg Traurig for Golf Club of Nevada, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Grendel, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark depicted below



for goods identified in the application, as amended, as "wearing apparel, namely, golf shirts, polo shirts, shirts, dress shirts, t-shirts, tank tops, sweatpants, sweatshirts, jogging suits, jeans, short pants, pants, dress pants, vests, sweaters, coats, jackets, blazers, blouses, skirts, dresses, lounge wear, swim wear, sleepwear, rompers, robes, socks, slippers, gloves, golf gloves, scarves, hats, caps and visors to be marketed and sold in relation to golf course services."<sup>1</sup> The application includes the following "description of the mark" statement: "The mark consists of a stylized depiction of a horse forming the letter 'S' in 'SECRETARIAT.'"

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark **SECRETARIAT**, previously registered (in standard character form) for "entertainment services, in the nature of thoroughbred racing,"<sup>2</sup> as to be likely to cause confusion,

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<sup>1</sup> Serial No. 76220155, filed March 1, 2001. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and August 1, 1999 is alleged to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

<sup>2</sup> Registration No. 1986605, issued July 16, 1996. Section 8 affidavit accepted.

to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The appeal is fully briefed. No oral hearing was requested. We reverse the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when considered in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc.* We find in this case that applicant's mark is similar to the cited registered mark. The dominant feature in the commercial impression created by both marks is the word SECRETARIAT. As applicant has acknowledged, its mark "is reminiscent of

the great race-horse, Secretariat, that won the Triple Crown in 1973, with victories in the Kentucky Derby, the Preakness Stakes and the Belmont Stakes." (Applicant's January 11, 2002 response to Office action, at 4.) We find that the horse's head design feature of applicant's mark is subordinate to, and merely reinforces the significance and dominance of, the name SECRETARIAT appearing in the mark. Viewing the marks in their entireties, we find that they are essentially identical in terms of appearance, sound, connotation and overall commercial impression. The first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

We turn next to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity between the goods identified in applicant's application and the services recited in the cited registration, and to the third *du Pont* factor, which requires us to consider the similarity or dissimilarity of the trade channels for the respective goods and services. It is settled that it is not necessary that the respective goods and services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods and services themselves, but rather whether they would be confused as to

the source of the goods and services. It is sufficient that the goods and services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon or in connection therewith, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods and services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The Trademark Examining Attorney has submitted printouts of ten third-party registrations (owned by six different owners) which include in their identifications of goods and services both horse racing services and clothing items. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert*

*Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).<sup>3</sup>

The Trademark Examining Attorney also has submitted printouts from thirteen Internet websites pertaining to horse racing venues or to racehorses (including one for Secretariat) which show use of the racetracks' or racehorses' names and marks in connection with the sale of clothing items.

If applicant's application had identified applicant's goods merely as clothing items, without further restriction, we would find that the Trademark Examining Attorney's third-party registration and Internet evidence likely suffices to establish the relatedness of such goods to the registrant's horse racing services. However, applicant has specifically limited its identification of goods to cover only clothing items "marketed and sold in relation to golf course services." We find that this restriction is significant and indeed dispositive in this case. There is no evidence of record which establishes any commercial link between horse racing services and golf course services, or, more to the point, between horse

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<sup>3</sup> Applicant's counter-submission of four third-party registrations which cover horse racing services only, but not clothing, does not detract from the evidentiary weight to be accorded to the third-party registrations submitted by the Trademark Examining Attorney under *Trostel*.

racing services and clothing sold solely in connection with golf course services.<sup>4</sup>

Even if we assume (looking beyond the face of the cited registration) that consumers might expect that the owner of the cited registration could use the registered mark in connection with clothing items as well as horse racing services, we simply have no evidentiary basis in this case for finding that purchasers encountering applicant's clothing items, which are sold only in connection with applicant's golf course services, are likely to assume that there is a source or other connection between such clothing and registrant's horse racing services. Both registrant's SECRETARIAT horse racing services and applicant's SECRETARIAT golf course and related clothing items might evoke the great racehorse

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<sup>4</sup> We also note that the record shows that in applicant's co-pending application Serial No. 76205570, by which applicant seeks registration of the same mark for "golf course services," the Trademark Examining Attorney ultimately withdrew her Section 2(d) refusal, which was based on the same cited registration as that involved in this case, in view of an apparent lack of evidence sufficient to show that golf course services and horse racing services are related for purposes of the likelihood of confusion analysis. After withdrawal of the refusal, applicant's mark in the co-pending application was published for opposition. A notice of opposition was filed by a party (not the owner of the cited registration in this case) claiming to have been the owner of the racehorse Secretariat and claiming to be the current owner of rights in the name SECRETARIAT. The opposition was later dismissed with prejudice pursuant to the parties' settlement agreement. A Notice of Allowance has issued with respect to applicant's co-pending application to register the mark for "golf course services."

Secretariat (the trademark rights to whom apparently are owned by a third person not a party herein), but that is not a sufficient basis for finding that consumers are likely to assume the existence of a source connection between applicant's specially-restricted clothing items and registrant's horse racing services.

In summary, notwithstanding the similarity of the marks in this case, we find that the trade channel limitation specified in applicant's identification of goods suffices to negate any likelihood of confusion.

Decision: The refusal to register is reversed.